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on May 11, 2010

TOWNSEND and TOWNSEND and CREW LLP

By:



Julie C. Myers

PATENT  
Attorney Docket No.: 018062-006210US  
Client Ref. No.: SF03-057

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Jack TAUNTON, et al.

Patent No.: 7,687,506 B2

Issued: March 30, 2010

Application No.: 10/552,847

Filed: August 9, 2006

For: SELECTIVE SERINE/THREONINE  
KINASE INHIBITORS

Customer No.: 20350

Confirmation No.: 2596

Examiner: Bruck Kifle

Art Unit: 1624

REQUEST FOR  
RECONSIDERATION OF PATENT  
TERM ADJUSTMENT  
DETERMINATION UNDER 37  
C.F.R. §1.705(d)

**Attn: Office of Petitions**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Commissioner:

Pursuant to 37 C.F.R. § 1.705(d), Applicants respectfully request  
reconsideration of the patent term adjustment determination. This request is accompanied by  
the fee set forth in §1.18(e) and a statement of facts as required under 37 C.F.R. §  
1.705(b)(2).

In view of the following it is respectfully requested that Applicants be granted  
a corrected patent term adjustment of 865 days.

**Statement of Facts as required under 37 C.F.R. § 1.705(b)(2)**

The correct patent term adjustment is 865 days, not 527 days as stated on the front page of U.S. Patent No. 7,687,506.

The period of adjustment under § 1.702(a) is 508 days (“A delay”).

The period of adjustment under § 1.702(b) is 535 days (“B delay”).

The period of adjustment under § 1.704(a) is 178 days (“applicant delay”).

The period of adjustment under § 1.703(f) is 865 days.

**The Relevant Dates as Specified in 37 C.F.R. §§ 1.703(a)-(e) , §§ 1.704 and the Adjustment Specified in 37 C.F.R. § 1.703(f)**

**1. § 1.703(a) as applied to U.S. National Stage Applications under § 371**

Applicants dispute that the Office did **not** correctly calculate the term adjustments to include the term adjustments that Applicants are entitled to under 37 CFR § 1.703(a) for a U.S. National Stage Application under § 371. The Office calculated 206 days as shown on the attached Exhibit A (Patent Term Adjustment History); however, this period of time actually began on December 11, 2006 (14 months after the date the application was filed) and ended on May 2, 2008 when an the first Office Action was mailed by the Office. Thus, the effective period of adjustment under 37 CFR § 1.703(a) is 508 days as shown in the table below.

Filing Date	14-month Date	Date of 1 <sup>st</sup> Office Action	Days over 14 months (§ 1.703(a)(1))
October 11, 2005	December 11, 2006	May 2, 2008	508 days

**2. § 1.703(b) as applied to U.S. National Stage Applications under § 371**

The Office failed to issue a patent within three years of the actual filing date of the above-referenced application. Applicants **do not** dispute the Office’s calculation of 535 days of term adjustments that Applicants are entitled to under 37 CFR § 1.702(b) and § 1.703(b).

**3. § 1.703(c)-(e)**

There are no relevant dates as specified under §§ 1.703(c)-(e).

**4. Overlapping periods under § 1.703(a)-(e)**

Applicants have calculated overlapping periods in accordance with *Wyeth v. Dudas* (88 U.S.P.Q.2d 1538, D.D.C. 2008). Periods of delay under 35 U.S.C. §154(b)(1)(A) and 35 U.S.C. §1.54(b)(1)(B) overlap only if they occur on the same calendar day or days (*see Wyeth*). There are no overlapping periods under § 1.703(a)-(e).

**5. Reduction of Period of Adjustment of Patent Term Under 37 C.F.R.  
§1.704(b)**

Applicants do dispute the Office's calculation of 214 days of term adjustments for Applicant Delay as indicated on the attached Patent Term Extension History (*see Exhibit A*). It appears that the Office incorrectly counted 1 day of Applicant delay triggered by the "Amendment after Notice of Allowance (Rule 312)" dated January 11, 2010. Further, the Office incorrectly started counting Applicant Delay triggered by the "Miscellaneous Incoming Letter" dated January 12, 2010 and counting 78 days. The correct calculation for Applicant Delay begins on January 11, 2010 with the "Amendment after Notice of Allowance (Rule 312)" through to February 23, 2010 when the Office mailed a Response to the 312 Amendment. Thus, Applicant Delay is 43 days, not 79 (78 + 1) days as stated on the attached Patent Term Extension History (*see Exhibit A*).

**6. § 1.703(f)**

The period of adjustment under 37 C.F.R. § 1.702(f) is as follows:

Type "A" delay:	508 days
Type "B" delay:	535 days
"A" and "B" overlap:	0 days
Applicant delay	178 days
<u>Adjusted</u>	<u>865 days</u>

**Terminal disclaimer**

The instant application is not subject to a terminal disclaimer.

**PATENT TERM ADJUSTMENT DETERMINATION**

Pursuant to *Wyeth v. Kappos* and *Wyeth v. Dudas* (Fed. Cir., Docket No. 2009-1120, January 7, 2010, and 88 U.S.P.Q.2d 1538, D.D.C. 2008) and the provisions regarding § 371 applications, Applicants are entitled to 865 days of patent term adjustment, *i.e.:*

[1043 + days (A delay + B delay) minus 0 overlap days] minus [178 days (applicant delay)].

Based on the foregoing, Applicants respectfully request reconsideration of the patent term adjustment determination.

Please charge the fee set forth in 37 C.F.R. §1.18(e) (\$200.00) to Deposit Order Account No. 20-1430. Please charge any necessary additional fees or credit any overpayments to our Deposit Order Account No. 20-1430.

Respectfully submitted,



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62399241 v1

**Exhibit A**

10/552,847	SELECTIVE SERINE/THREONINE KINASE INHIBITORS	05-06-2010::16:48:16
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**Patent Term Adjustments**

Patent Term Adjustment (PTA) for Application Number: 10/552,847

Filing or 371(c) Date:	08-09-2006	USPTO Delay (PTO) Delay (days):	-
Issue Date of Patent:	03-30-2010	Three Years:	-
Pre-Issue Petitions (days):	-	Applicant Delay (APPL) Delay (days):	-
Post-Issue Petitions (days):	-	Total PTA (days):	527
USPTO Adjustment(days):	-	Explanation Of Calculations	

**Patent Term Adjustment History**

Date	Contents Description	PTO(Days)	APPL(Days)
03-30-2010	PTA 36 Months	535	
03-30-2010	Patent Issue Date Used in PTA Calculation		
02-27-2010	Dispatch to FDC	↑	
02-23-2010	Mail Response to 312 Amendment (PTO-271)	↑	
02-22-2010	Response to Amendment under Rule 312	↑	
01-11-2010	Amendment after Notice of Allowance (Rule 312)	1	
02-18-2010	Application Is Considered Ready for Issue	↑	
02-17-2010	TC Return to Pubs	↑	
02-01-2010	Issue Fee Payment Verified	↑	
02-04-2010	Pubs Case Remand to TC	↑	
02-02-2010	Mail Response to 312 Amendment (PTO-271)	↑	
02-01-2010	Issue Fee Payment Received	↑	
02-01-2010	Response to Amendment under Rule 312		
01-12-2010	Miscellaneous Incoming Letter	78	
01-12-2010	Amendment after Notice of Allowance (Rule 312)		
11-30-2009	Mail Notice of Allowance		
11-24-2009	Document Verification		
11-24-2009	Notice of Allowance Data Verification Completed		
11-24-2009	Case Docketed to Examiner in GAU		
11-20-2009	Date Forwarded to Examiner		
11-19-2009	Amendment after Final Rejection		
09-28-2009	Mail Final Rejection (PTOL - 326)		
09-25-2009	Final Rejection		
07-21-2009	Date Forwarded to Examiner		
06-16-2009	Response after Non-Final Action	61	
06-16-2009	Request for Extension of Time - Granted	↑	
01-16-2009	Mail Non-Final Rejection	↑	
01-15-2009	Non-Final Rejection		
11-04-2008	Date Forwarded to Examiner		
10-15-2008	Response after Non-Final Action	74	
10-15-2008	Request for Extension of Time - Granted	↑	

**Exhibit A**

05-02-2008	Mail Non-Final Rejection	206
04-28-2008	Non-Final Rejection	↑
08-09-2006	Information Disclosure Statement considered	↑
08-09-2007	Case Docketed to Examiner in GAU	↑
04-12-2007	PG-Pub Issue Notification	↑
02-02-2007	Case Docketed to Examiner in GAU	↑
01-23-2007	IFW TSS Processing by Tech Center Complete	↑
10-05-2006	Miscellaneous Incoming Letter	↑
08-09-2006	Reference capture on IDS	↑
08-09-2006	Information Disclosure Statement (IDS) Filed	↑
08-09-2006	Information Disclosure Statement (IDS) Filed	↑
08-09-2006	371 Completion Date	↑
01-09-2007	Application Dispatched from OIPE	
08-09-2006	Additional Application Filing Fees	
08-09-2006	Information Disclosure Statements	
08-09-2006	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic	

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